



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,469	10/31/2001	Aya Jakobovits	511582002420	3304

25225 7590 05/05/2003

MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO, CA 92130-2332

EXAMINER

DAVIS, MINH TAM B

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 05/05/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,469

Applicant(s)

JAKOBOVITS ET AL.

Examiner

MINH-TAM DAVIS

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48 and 50-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 48, 50-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Applicant's election of group I, claims 48 and 50 in paper No:14 is acknowledged.

Applicant amends claim 48 and adds new claims 51-52.

New restriction is required in view of the amendment of claim 48 and the addition of claims 51-52.

Election/Restrictions

It is noted that the claims of the instant application have been determined to include linking claim 48. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 48. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

This application contains claims directed to the following patentably distinct inventions linked by claim 48:

Art Unit: 1642

- I. Claims 48, 50-51, drawn to a method to identify an agent that promotes colony formation, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.
- II. Claims 48, 50-51, drawn to a method to identify an agent that decreases the invasion and metastasis of cancer cells, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.
- III. Claims 48, 50-51, drawn to a method to identify an agent that increases the invasion and metastasis of cancer cells, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.
- IV. Claims 48, 50-51, drawn to a method to identify an agent that alters cell cycle, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.
- V. Claims 48, 50-51, drawn to a method to identify an agent that decreases ERK phosphorylation by FBS, LPA, GRP or PAF, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.
- VI. Claims 48, 50-51, drawn to a method to identify an agent that increases ERK phosphorylation by FBS, LPA, GRP or PAF, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.
- VII. Claims 48, 50-51, drawn to a method to identify an agent that activates p38, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.

VIII. Claims 48, 50-51, drawn to a method to identify an agent that increases cell growth, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.

IX. Claims 48, 50-51, drawn to a method to identify an agent that decreases cell growth, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.

X. Claims 48, 52, drawn to a method to identify an agent that alters 101P3A11 protein sequence, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.

XI. Claims 48, 50, 52, drawn to a method to identify an agent that alters 101P3A11 peptide localization, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 4.

XII. Claims 48, 50, 52, drawn to a method to identify an agent that increases the levels of 101P3A11 peptide, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 7.1.

XIII. Claims 48, 50, 52, drawn to a method to identify an agent that decreases the levels of 101P3A11 peptide, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 7.1.

XIV. Claims 48, 50, 52, drawn to a method to identify an agent that increases association of 101P3A11 peptide with polypeptide binding partners, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 7.1.

Art Unit: 1642

XV. Claims 48, 50, 52, drawn to a method to identify an agent that decreases association of 101P3A11 peptide with polypeptide binding partners, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 7.1.

XVI. Claims 48, 50, 52, drawn to a method to identify an agent that increases the mRNA levels of 101P3A11, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 6.

XVII. Claims 48, 50, 52, drawn to a method to identify an agent that decreases the mRNA levels of 101P3A11, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 6.

XVIII. Claims 48, 50, 52, drawn to a method to identify an agent that alters 101P3A11 RNA sequence, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 6.

XIV. Claims 48, 50, 52, drawn to a method to identify an agent that perturbs the 101P3A11 DNA, thereby decreasing the expression status of 101P3A11 protein, classified in class 435, subclass 6.

In addition, upon election of any of groups V, VI, further election of the following species is required:

FBS, LPA, GRP or PAF.

The inventions are distinct, each from each other because of the following reasons:

The methods of groups I-VIII are distinct from each other because they differ at least in objectives, method steps, reagents and/or dosages, and/or schedules used, response variables and criteria for success.

The species are distinct because they are structurally distinct.

Because these inventions are distinct for the reason given above and have acquired a separate status in the art, because the searches for the groups are not co-extensive, and therefore, it would be a serious burden for the Examiner to search all the groups together, restriction for examination purposes as indicated is proper.

Applicants are required under 35 USC 121 to elect a single disclosed group for prosecution on the merits to which the claims shall be restricted. Applicant is further advised that if Applicant elects a group having species requirement, a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 703-305-2008. The examiner can normally be reached on 9:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANTHONY CAPUTA can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

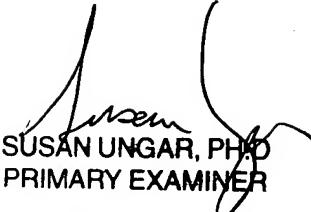
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

Application/Control Number: 10/001,469
Art Unit: 1642

Page 8

MINH TAM DAVIS

December 13, 2002


SUSAN UNGAR, PHD
PRIMARY EXAMINER